

REMARKS

Upon entry of the instant Response, Claims 1-10 and 12-25 will remain pending in this application.

In the Office Action mailed March 13, 2009, Claims 1-10 and 12-25 are rejected under 35 U.S.C. §102(b), as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,822,045 issued to Miyatake et al. Claims 1-10 and 12-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,822,045 issued to Miyatake et al.

Rejections under 35 U.S.C. §§102(b)/103(a) as anticipated and/or rendered unpatentable by Miyatake et al.

Claims 1-10 and 12-25 stand rejected under 35 U.S.C. §102(b), as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,822,045 issued to Miyatake et al. Beginning at page 2 of the Final Office Action mailed March 13, 2009, the Examiner states,

Patentees disclose a process in which a latex "A" (referred to as a "silicone rubber" but containing both containing acrylic as well as crosslinked silicone polymers) are coagglomerated with a latex "B" while conducting polymerization of vinyl rubbers, i.e. grafting is taking place during coagglomeration and as such the graft copolymers formed during the process would be coagglomerated. Note the Abstract in this regard. Redox polymerization is preferred for production of "B" at column 10, lines 41-43. Both "A" and "B" may be crosslinked at column 7, lines 17-20 as well as column 9, lines 33-36. It is noted that applicants "consisting of" language only pertains to materials used in a redox system and do not exclude materials present in non redox systems such as may possibly be present in patentees' final cografting step. In any case no evidence has been presented that the products of redox and non redox persulfate polymerization differ and as both types of systems result in addition polymerized acrylates the product of patentees and applicants would reasonably appear to be the same.

Product-by-process claims are not rejected using the approach set out in *Graham v. Deere*. It is applicant's burden to show that there is a non-obvious difference between the product of a product-by-process claim and a prior art product which reasonably appears to be the same or only slightly different whether or not the prior art product is produced in the same manner as the claimed product. Note *In re Marosi*, 218 USPQ 289, 292-293 (CAFC 1983); *In*

re Brown, 173 USPQ 685 (CCPA 1972) and In re Thorpe, 227 USPQ 964 (CAFC 1985) in this regard.

Miyatake et al. disclose a rubber modified resin prepared by polymerizing a vinyl monomer in the presence of mixed rubber latex and require co-agglomeration of the rubber particles in the mixture to take place during polymerization. The resulting graft polymer includes co-agglomerated rubber particles. In contradistinction, the present invention makes two graft polymers separately and then, after polymerization, mixes and co-precipitates the resulting mixture. The requirement of Miyatake et al. that the polymerization of vinyl monomers be carried out in the presence of both rubbers cannot be seen as describing or fairly suggesting the instantly recited invention wherein each of the rubbers undergoes polymerization separately from the other.

Therefore, applicants respectfully request the Examiner reconsider and reverse his rejection of Claims 1-10 and 12-25 under 35 U.S.C. §102(b), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,822,045 issued to Miyatake et al.

Rejections under 35 U.S.C. §103(a) as being rendered unpatentable by Miyatake et al.

Claims 1-10 and 12-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,822,045 issued to Miyatake et al. beginning at page 3 of the Final Office Action mailed August 14, 2008, the Examiner states,

No examples of processes having all of applicants limitations including use of redox polymerization to produce patentees "B" which applicants may argue has a material effect on the product produced as compared to non redox or use of combinations of redox, non redox polymerization. However choice of applicants various limitations from the patent would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results.

Applicant's arguments filed 1-9-09 have been fully considered but they are not persuasive. Applicants argue that each element of the claim must be present in a reference. However polymerization of rubbers separately is not an element of the instant claims which recite no such limitation. Limitations not present in the claims are given no weight. Patentees disclose that at least two kinds of

polymer particles are present prior to agglomeration (column 11, lines 50-54) despite formation of two lattices at the same time. The co-agglomerated lattices of the patent Examples are still in latex form and any coagglomerated latex particle is a mixture of different lattices. Whether or not applicants agree with this "COMPARATIVE EXAMPLE 1" in column 18 of the patent is not co-agglomerated before co-precipitation and it is therefore not clear how the limitation that "each of the rubbers undergoes polymerization separate from the other" would distinguish over the comparative Example even if such a limitation were present in the claims. Lastly, while it appears that all elements of applicants process steps are disclosed by the references, applicants are claiming a product not a process and it is immaterial that process steps not resulting in product differences may not be present.

Applicants respectfully disagree with the Examiner's statement above that "...polymerization of rubbers separately is not an element of the instant claims which recite no such limitation". Applicants question how graft polymer B.1 in latex form that is prepared by means of a redox initiation system and graft copolymer B.2 in latex form that is prepared by means of an initiation system consisting of persulfate compounds could not be prepared separately. Further, applicants respectfully contend that such separate preparation would be apparent to one of ordinary skill in the art from a fair reading of the claims. Thus, applicants contend that separate preparation is indeed found in the claims. As to the weaknesses of the reference alluded to above by the Examiner, "process steps not resulting in product differences may not be present", applicants note the Examiner has chosen the reference he wishes to rely upon.

Therefore, Applicants contend that nothing in the teaching of Miyatake et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse his rejection of Claims 1-10 and 12-25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,822,045 issued to Miyatake et al.

Conclusion

Applicants have made no claim amendments as they submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 1-10 and 12-25. If the Examiner is of the opinion that the instant application is in condition for other than allowance, he is invited to contact the applicants' Attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

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